

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

Appellant(s) :	Marybeth Ahern	Group Art Unit: 3623
Appln. No. :	10/643,987	Examiner: Kardos, Neil R
Filed :	August 20, 2003	Confirmation No.: 5154
For :	E-BUSINESS VALUE WEB	

APPEAL BRIEF UNDER 37 C.F.R. §41.37

Commissioner for Patents
United States Patent and Trademark Office
Customer Service Window, Mail Stop Appeal Brief-Patents
Randolph Building
401 Dulany Street
Alexandria, VA 22314

Sir:

This appeal is from the Examiner's rejection of claims 1-8, 10, 32-41, and 52-63 as set forth in the Final Office Action dated March 2, 2010. A Notice of Appeal was timely submitted on May 6, 2010. Payment of the Appeal Brief fee set forth in 37 C.F.R. §41.20(b)(2) is submitted herewith. Accordingly, this Appeal Brief is being timely submitted, and Appellants' believe that no additional fees are necessary at this time. However, if any fees are necessary for consideration of this Appeal Brief, the undersigned authorizes the charging of any filing fees for the Appeal Brief and/or any necessary extension of time fees to Deposit Account No. 09-0457.

(I) REAL PARTY IN INTEREST

The real party in interest is International Business Machines Corporation of Armonk, New York, assignee of the entire interest in the above-identified application by an assignment recorded in the U.S. Patent and Trademark Office on August 20, 2003, at Reel 014419 and Frame 0055.

(II) RELATED APPEALS AND INTERFERENCES

The Appellants, their legal representatives and the Assignees are not currently aware of any appeals, interferences, or judicial proceedings that may directly affect or be directly affected by or have some bearing on the Board's decision in this appeal. Attached hereto is a Related Proceedings Appendix showing no related appeals or interferences.

(III) STATUS OF THE CLAIMS

In the Final Office Action dated March 2, 2010 ("Final Office Action"), claims 1-8, 10, 32-41, and 52-63 are pending and rejected. Claims 9, 11-31, and 42-51 are canceled. No claims are allowed, objected to, or withdrawn. Accordingly, claims 1-8, 10, 32-41, and 52-63 are being appealed and are listed in the "Claims Appendix" attached herewith.

(IV) STATUS OF THE AMENDMENTS

All amendments have been entered. Accordingly, claims 1-8, 10, 32-41, and 52-63 as presented in the Amendment filed May 3, 2010, are being appealed and are listed in the "Claims Appendix" attached herewith.

(V) SUMMARY OF THE CLAIMED SUBJECT MATTER**Independent Claim 1**

By way of non-limiting example, the invention provides a method for managing and tracking changes in an organization. The method includes operations of defining at least one customer requirement for an enhancement to an enterprise architecture (see operation 505, FIG. 4, see also paragraph [0053]), identifying at least one capability to provide the enhancement to the enterprise architecture (see operation 510, FIG. 4, see also paragraph [0053]), estimating at least one of a revenue increase and a cost saving associated with the at least one capability(see operation 515, FIG. 4, see also paragraph [0053]), and determining a value provided by the at least one capability based upon an implementation cost and the at least one of the revenue increase and the cost saving (see operation 520, FIG. 4, see also paragraph [0054]). The method also includes using a database to store a hierarchical relationship of a goal, the value, the at least one capability, and a resource, the hierarchical relationship having a plurality of levels with one or more dynamic links that differ between the plurality of levels (see paragraphs [0012], 0016, and [0019]-[0022]), displaying the hierarchical relationship between the goal, the value which is associated with the goal, the at least one capability which represents critical functions for ensuring delivery of the value, and one or more resources which enables the at least one capability (see FIG. 2D), and capturing and linking process measurements from one or more external modeling tools to the database to allow process performance to be accessed by the system (see paragraph [0031]). The method further includes using a system implemented on a computer platform to partition information relevant to enterprise decision making for evolutionary change by creating categories of the information and relating these categories to one another (see paragraph [0016]), the information being defined by at least one of the value, the at least one capability, and operational resources (see paragraphs [0020] – [0022]), and

using an automated system to manage the categories of the information (see paragraph [0016]). In addition, the method further comprises one or both of: capturing and displaying current resources of the organization and how they relate to the organizations' mission in real-time, directly tracking which specific resources directly support the capabilities, and illustrating and quantifying a value of transforming an enterprise business model of the organization from a current "as-is" state to a proposed "to-be" business model (see paragraphs [0013] and [0015]); and defining the goal as a corporate directive establishing a final end point of an enterprise change(see paragraph [0019]), defining the value as a customer value (see paragraph [0021]), the at least one capability is a strategic capability that represents critical functions that the organization must be capable of performing to insure delivery of the customer value, and defining the resource as a physical component that must be present and supports the at least one capability (see paragraph [0022]).

Independent Claim 32

By way of non-limiting example, the invention provides a system comprising hardware and software for managing and tracking changes in an organization. The system includes a system for defining at least one customer requirement for an enhancement to an enterprise architecture(see paragraph [0020]), a system for identifying at least one capability to provide the enhancement to the enterprise architecture (see paragraph [0021]), a system for estimating at least one of a revenue increase and a cost saving associated with the at least one capability (see paragraph [0053]), a system for determining a value provided by the at least one capability based upon the implementation cost and the at least one of a revenue increase and the cost saving (see paragraph [0054]), and a system for storing a hierarchical relationship of a goal, the value, the at least one capability, and a resource, the hierarchical relationship having a plurality of levels with

one or more dynamic links that differ between the plurality of levels (see paragraphs [0012], [0016], and [0019]-[0022]). The system further includes a graphic user interface (GUI) for displaying the hierarchical relationship between the goal, the value which is associated with the goal, the at least one capability which represents critical functions for ensuring delivery of the value, and one or more resources which enables the at least one capability and a system for partitioning information relevant to enterprise decision making for evolutionary change by creating categories of the information and relating these categories to one another and managing the categories of the information using an automated system (see reference numerals 210, 240, 250, FIGS. 2A-2D, see also paragraph [0016]), the information being defined by at least one of the value, the at least one capability, and operational resources (see paragraphs [0020]-[0022]). The system further includes a system for capturing and linking process measurements from one or more external modeling tools to a database to allow process performance to be accessed by the system (see paragraph [0031]). The system for managing and tracking changes captures and displays current resources of the organization and how they relate to the organizations' mission in real-time, tracks which specific resources directly support the capabilities, and illustrates and quantifies a value of transforming an enterprise business model of the organization from a current "as-is" state to a proposed "to-be" business model (see paragraphs [0013]-[0015]).

Independent Claim 52

By way of non-limiting example, the invention provides a computer program product usable for managing and tracking changes in an organization and comprising a computer usable storage medium having readable program code embodied in the medium. The computer program product includes a first computer code to define at least one customer requirement for an enhancement to an enterprise architecture (see FIG. 4, operation 505, and paragraph [0053]), a

second computer code to identify at least one capability to provide the enhancement to the enterprise architecture (see FIG. 4, operation 510, and paragraph [0053]), a third computer code to estimate at least one of a revenue increase and a cost saving associated with the at least one capability (see FIG. 4, operation 515, and paragraph [0053]), and a fourth computer code to determine a value provided by the at least one capability based upon the implementation cost and the at least one of a revenue increase and the cost saving (see FIG. 4, operation 520, and paragraph [0054]). The computer program product further includes a fifth computer code to partition information relevant to enterprise decision making for evolutionary change by creating categories of the information and relating these categories to one another and manage the categories of the information using an automated system, the information being defined by at least one of the value, the at least one capability, and operational resources (see paragraphs [0016] and [0020]-[0022]). The computer program product also includes a sixth computer code to capture and link process measurements from one or more external modeling tools to a database to allow process performance to be accessed (see paragraph [0031]), a seventh computer code to store a hierarchical relationship of a goal, the value, the at least one capability, and a resource, the hierarchical relationship having a plurality of levels with one or more dynamic links that differ between the plurality of levels (see paragraphs [0012], [0016], and [0019]-[0022]), and an eighth computer code to display on a graphic user interface (GUI) the hierarchical relationship between the goal, the value which is associated with the goal, the at least one capability which represents critical functions for ensuring delivery of the value, and one or more resources which enables the at least one capability (see at least reference numerals 210, 240, 250, FIGS. 2A-2D). The goal is defined as a corporate directive establishing a final end point of an enterprise change (see paragraph [0019]), the value is defined as a customer value (see paragraph [0020]), the at least one capability is a strategic capability that represents critical

functions that the organization must be capable of doing to insure delivery of the customer value (see paragraph [0021]), and the resource is defined as a physical component that must be present and supports the at least one capability (see paragraph [0022]).

(VI) GROUNDS OF REJECTION TO BE REVIEWED ON APPEAL

(A) Claims 1-8, 10, 32-41 and 52-62 were rejected under 35 U.S.C. §103(a) for allegedly being unpatentable over a Paper entitled ALIGNING ENTERPRISE ARCHITECTURE AND IT INVENTMENTS WITH CORPORATE GOALS by BUCHANAN et al. (“BUCHANAN”) in view of a Paper entitled Multi-Perspective Enterprise Modeling (MEMO) – Conceptual Framework and Modeling Languages by FRANK (“FRANK”) and in further view of U.S. Patent Application Publication No. 2003/0046130 to GOLIGHTLY et al. (“GOLIGHTLY”).

(B) Claim 63 was rejected under 35 U.S.C. §103(a) for allegedly being unpatentable over a Paper entitled ALIGNING ENTERPRISE ARCHITECTURE AND IT INVENTMENTS WITH CORPORATE GOALS by BUCHANAN et al. (“BUCHANAN”) in view of a Paper entitled Multi-Perspective Enterprise Modeling (MEMO) – Conceptual Framework and Modeling Languages by FRANK (“FRANK”) and in further view of U.S. Patent Application Publication No. 2003/0046130 to GOLIGHTLY et al. (“GOLIGHTLY”) and in further view of References Architectures for Enterprise Integration by Chalmeta (“Chalmeta”).

(VII) ARGUMENTS

(A) Claims 1-8, 10, 32-41 and 52-62 were rejected under 35 U.S.C. §103(a) for allegedly being unpatentable over Paper entitled ALIGNING ENTERPRISE ARCHITECTURE AND IT INVENTMENTS WITH CORPORATE GOALS by BUCHANAN et al. ("BUCHANAN") in view of a Paper entitled Multi-Perspective Enterprise Modeling (MEMO) – Conceptual Framework and Modeling Languages by FRANK ("FRANK") and in further view of U.S. Patent Application Publication No. 2003/0046130 to GOLIGHTLY et al. ("GOLIGHTLY").

Claims 1-8, 10, 32-41 and 52-62

Independent Claim 1

The rejection of independent claim 1 under 35 U.S.C. §103(a) is in error, and the decision to reject this claim should be reversed.

The examiner bears the initial burden of factually supporting any *prima facie* conclusion of obviousness. If the examiner does not produce a *prima facie* case, the applicant is under no obligation to submit evidence of nonobviousness. To establish a *prima facie* case of obviousness, three basic criteria must be met. First, there must be some suggestion or motivation, either in the references themselves or in the knowledge generally available to one of ordinary skill in the art, to modify the reference or to combine reference teachings.¹ Second, there must be a reasonable expectation of success. Finally, the prior art reference (or references when combined) must teach or suggest all the claim limitations. The teaching or suggestion to make the claimed combination and the reasonable expectation of success must both be found in the prior art, and not based on

¹ While the *KSR* court rejected a rigid application of the teaching, suggestion, or motivation ("TSM") test in an obviousness inquiry, the [Supreme] Court acknowledged the importance of identifying "a reason that would have prompted a person of ordinary skill in the relevant field to combine the elements in the way the claimed new invention does" in an obviousness determination. *Takeda Chemical Industries, Ltd. v. Alphapharm Pty., Ltd.*, 492 F.3d 1350, 1356-1357 (Fed. Cir. 2007) (quoting *KSR International Co. v. Teleflex Inc.*, --- U.S. ----, 127 S.Ct. 1727, 1731 (2007)).

applicant's disclosure. *In re Vaeck*, 947 F.2d 488, 20 USPQ2d 1438 (Fed. Cir. 1991). See MPEP §2142.

The present invention is related to an enterprise management support system, and more particularly, to a decision-making system to evaluate enterprise decisions. More specifically, independent claim 1 recites:

1. A method for managing and tracking changes in an organization, the method comprising the steps of:
 - defining at least one customer requirement for an enhancement to an enterprise architecture;
 - identifying at least one capability to provide the enhancement to the enterprise architecture;
 - estimating at least one of a revenue increase and a cost saving associated with the at least one capability;
 - determining a value provided by the at least one capability based upon an implementation cost and the at least one of the revenue increase and the cost saving;
 - using a database to store a hierarchical relationship of a goal, the value, the at least one capability, and a resource, the hierarchical relationship having a plurality of levels with one or more dynamic links that differ between the plurality of levels;
 - displaying the hierarchical relationship between the goal, the value which is associated with the goal, the at least one capability which represents critical functions for ensuring delivery of the value, and one or more resources which enables the at least one capability;
 - capturing and linking process measurements from one or more external modeling tools to the database to allow process performance to be accessed by the system;
 - using a system implemented on a computer platform to partition information relevant to enterprise decision making for evolutionary change by creating categories of the information and relating these categories to one another, the information being defined by at least one of the value, the at least one capability, and operational resources; and
 - using an automated system to manage the categories of the information,
 - wherein the method further comprises one or both of:
 - (i) capturing and displaying current resources of the organization and how they relate to the organizations' mission in real-time, directly tracking which specific resources directly support the capabilities, and illustrating and quantifying a value of transforming an enterprise

business model of the organization from a current “as-is” state to a proposed “to-be” business model; and
(ii) defining the goal as a corporate directive establishing a final end point of an enterprise change, defining the value as a customer value, the at least one capability is a strategic capability that represents critical functions that the organization must be capable of performing to insure delivery of the customer value, and defining the resource as a physical component that must be present and supports the at least one capability.

Appellants submit that no proper combination of the applied art teaches or suggests each and every feature of the claimed invention.

No Teaching of Capturing and Displaying

Current Resources of the Organization and

How They Relate to the Organization’s Mission in Real-Time

Appellants submit that the combination of Buchanan, Frank, and Golightly does not disclose *capturing and displaying current resources of the organization and how they relate to the organizations’ mission in real-time*, as recited in claim 1.

Buchanan’s paper discloses that CEO’s of corporations are generally unsatisfied with how their IT organizations perform. For example, Buchanan discloses a study which indicates that fewer than 25% of IT projects conducted by Fortune 500 companies between 1998 and 1999 met their narrowly defined project goals. In response to the dissatisfaction of how IT organizations perform, Buchanan implies there is much improvement needed in areas of IT development and, accordingly, discloses an approach to strategic planning, architecture development, and software project management to address this problem.

On page 2 of Buchanan’s disclosure, Buchanan indicates that most complex organizations conduct some form of business strategic planning, often coordinated by strategy and planning committees. Buchanan also discloses that, in a well-aligned company, IT

organizations would derive its goals and priorities from the corporate strategy and planning groups. This would insure that IT projects routinely support corporate goals. Buchanan, however, notes that most organizations lack a mechanism that can align or “bridge the gap” between the concerns of corporate strategists and IT project managers. Buchanan’s paper, therefore, focuses on an Enterprise Architecture Process as a mechanism for bridging the aforementioned gap.

The Enterprise Architecture Process, disclosed by Buchanan, represents a process, not a thing. The enterprise architecture, in effect, describes logical linkages between enterprise business, information and technical architectures, and enterprise solutions architecture. In Buchanan’s disclosure, the traditional notion of an enterprise architecture is extended so that the hierarchy of architectures extends from a business strategy level and links it to an IT implementation level. This enables an organization to align business goals and IT investment plans, and facilitate communication and decision-making between business strategy and IT management groups.

FIG. 4 of Buchanan’s disclosure represents an Enterprise Architecture process model. As explained on page 5 of Buchanan’s disclosure, the Enterprise architecture is a top-down, business strategic driven process that coordinates the parallel development of an enterprise business architecture (EBA), an enterprise information architecture (EIA), an enterprise-wide technology architecture (EWTA), as well as an enterprise application portfolio (EAP). Conducted within an appropriate collaborative, organization/governance context, EA artifacts consists of a common requirements vision (CRV), conceptual architecture (CA), as well as current and future state models of the aforementioned architectures described above.

On page 5 of Buchanan’s disclosure (second paragraph), Buchanan indicates that the EA process is a “top down” process in the sense that its analysis begins by looking at the new market,

competitive and other environmental forces that may affect the organization. Once new opportunities and threats are identified, the strategy and planning group must decide if they warrant changes in the company's strategies. This results in a new or refined business vision which in turn, results in a new business strategy.

Appellants note that Buchanan, while speaking very general terms about Enterprise Architecture process, never discloses, with any particularity, how the processes are to be carried out or implemented. As an example, Appellants note that Buchanan, in paragraphs 3 and 4 of page 5, discloses:

Despite the fancy term, an enterprise business architecture is simply a more precise description of an organization's business strategy. It answers the question, "Given our business strategy and goals, who is going to do what?" In other words, it identifies (in a very targeted, pragmatic way) which assets will engage in what processes in support of the forward business strategy. The formation definition is as follows:

An enterprise business architecture is a business vision-driven process, that decomposes the enterprise's business strategies, the assets and processes required to execute them, as well as their impact on business functions. Artifacts of the EBA consist of a Common Requirements Vision (CRV), Conceptual Architecture (CA), as well as current and future state models of business activity that articulate the extended enterprise value chain. EBA is implements through the enterprise's EIA, EWTA, and EAP, and defines the business design for sustainable competitive advantage.

Appellants note the Examiner relied on the above two paragraphs for disclosing *capturing and displaying current resources of the organization and how they relate to the organization's mission in real-time*, as recited in claim 1. Contrary to the Examiner's assertion, however, the above cited passages only generally discuss an enterprise business architecture. Furthermore, while the passages may indicate that the architecture includes goals and players who can perform various operations, the cited portions clearly fail to disclose, at least, the operation of *capturing and displaying current resources of the organization and how they relate*

to the organization's mission in real-time, as recited in claim 1. Accordingly, Appellants submit the Examiner has failed to show the instant feature is disclosed by Buchanan.

Appellants further submit that Frank does not disclose, at least, an operation of *capturing and displaying current resources of the organization and how they relate to the organization's mission in real-time*, as recited in claim 1. The Examiner asserts the instant feature is disclosed by Frank in FIGS. 3 and 4. Appellants respectfully disagree.

Frank generally discloses a need for providing information systems that are consistent with strategic and organizational guidelines. Accordingly, Frank's disclosure is aimed at enterprise modeling and, in particular using "Multi Perspective Enterprise Modeling" (MEMO) as a method for enterprise modeling. Frank explains that the basic idea behind enterprise modeling is to offer different views on an enterprise. These views should complement one another to foster a better understanding of complex systems by emphasizing the appropriate abstractions

On page 3 of Frank's disclosure, Frank teaches that a construction of an enterprise model requires a common understanding of essential abstractions. Such a "big picture" does not only serve as a common reference but also serves as a framework to integrate special purpose models. Frank further explains that MEMO offers a generic conceptual framework that corresponds to common abstractions in business firms. Frank also explains that the construction of an enterprise model will usually start with the modeling of a corporate strategy followed by steps of analyzing and redesigning core business processes.

Frank further discloses that MEMO offers three specialized languages that support the construction of an enterprise system: 1) strategy modeling language (MEMO-SML); 2) organization modeling language (MEMO-OrgML); and 3) object-oriented modeling language (MEMO-OML). FIG. 3 shows excerpts of models designed with these three languages.

Although this figure shows various elements associated with modeled enterprise system, Frank does not disclose displaying any of the symbols illustrated in FIG. 3 much less displaying the alleged current resource and how it relates to an organization's mission in real time.

Accordingly, Frank does not actually disclose, at least, *capturing and displaying current resources of the organization and how they relate to the organization's mission in real-time*, as recited in claim 1. Rather, Frank is silent regarding this feature.

Additionally, Frank discloses that MEMO modeling languages are specified in the same meta-language (see page 9). Hence, from a formal point of view, Frank indicates that it is easy to define common concepts for a set of modeling languages. Nevertheless, Frank indicates that the identification of appropriate concepts that may serve as interfaces between different kinds of models requires carefully coordinating the development of the corresponding languages. FIG. 4 illustrates the integration of MEMO OML, MEMO OrgMLO, and MEMOSML. However, Frank does not disclose, at least, *capturing and displaying current resources of the organization and how they relate to the organization's mission in real-time*, as recited in claim 1. Rather, Frank is silent regarding this feature.

Golightly discloses a system and method for asynchronous distributed optimization of an enterprise. However, Golightly makes no mention of *capturing and displaying current resources of the organization and how they relate to the organization's mission in real-time*, as recited in claim 1. Rather, Golightly is silent regarding this feature.

As outlined above, none of Buchanan, Frank, and Golightly teach suggest or disclose, at least, *capturing and displaying current resources of the organization and how they relate to the organization's mission in real-time*, as recited in claim 1. Therefore, Appellants submit that no proper combination of the applied art teaches or suggests each and every feature of the claimed

invention. Accordingly, Appellants submit the combination of the applied art does not render the instant feature obvious.

For at least the reasons presented above, Appellants respectfully request the rejection of claim 1 as being obvious over the combination of Buchanan, Frank, and Golightly be reversed.

No Teaching of Illustrating and Quantifying

a Value of Transforming an Enterprise Business

Model of the Organization from a Current

“As-Is” State to a Proposed “To-Be” Business Model

Contrary to the Examiner’s assertion, Buchanan does not disclose *illustrating and quantifying a value of transforming an enterprise business model of the organization from a current “as-is” state to a proposed “to-be” business model*, as recited in claim 1. The Examiner insists the instant feature is disclosed by Buchanan. For support, the Examiner asserts that: page 2, paragraph 3 of Buchanan’s disclosure teaches identifying gaps between current state and future architectures; page 5 discloses current and future state models; and page 3 discloses using value measures to guide decisions. The Examiner also asserts page 7 teaches the instant features. Appellants respectfully disagree that any of the cited portions of Buchanan can be relied on to disclose the instant feature.

For convenience, Appellants have reproduced the Examiner’s cited portions below. For example, the third paragraph of page 2 recites:

Based upon their research on industry best practices, META Group has developed such a mechanism, which it refers to as the Enterprise Architecture Process. For META Group, Enterprise Architecture represents a process, not a thing. The process will result in the creation and interactive refinement of many artifacts that collectively define a future architecture, and it will identify the gaps between the current state and this future architecture. The enterprise architecture, in effect, describes the logical linkages between the enterprise business, information and technical architectures and the enterprise solutions architecture. The traditional

notion of an enterprise architecture is extended so that the hierarchy of architectures extends from the business strategy level and links to the IT implementation level. This enables organizations to align business goals and IT investment plans, and facilitates communication and decision-making between business strategy and IT management groups. (See Figure 1 and Figure 2.)

As another example, the cited portion of page 3 states:

One concept that is key to understanding the role of the Enterprise Architecture is the concept of value. Too many organizations us this term too narrowly, and define it in terms of purely financial goals. In other words, they define value in terms of reduced costs. In fact, value, rightly considered involves two interacting concepts: financial efficiency and business effectiveness. Financial efficiency results from reducing costs or enhancing the financial yield from investments. Business effectiveness results when the company increased its market share, beats competitors, improves quality or cements a tighter relationship with customers. Board members often focus on business effectiveness while middle managers are more likely to focus only on financial efficiency. Effective companies need to develop measures that capture both aspects of value, and use these enhanced and more complete value measures to guide their investment and architectural decisions.

As another example, the cited portion of page 7 recites:

As specific models emerge from the information and technical architectures, they are fed “downstream” into the organization’s Program Management function. Any change in principles or in models results in an analysis of the gap between what already exists and what is called for by the changed strategy and the redefined enterprise architecture. Based on values and priorities assigned to requirements and principles, IT is in a position to create a set of priorities for modification and to plan changes. For most IT organizations, this is a major shift. Projects are not undertaken based on arbitrary criteria, according to who is “screaming the loudest” for them or because of lobbying by a specific business manager. Instead, IT investments are made according to objective measures of business strategic value and in accordance with a long term plan for infrastructure and architecture development. Moreover, when business strategies change, IT investment plans can change dynamically in response.

Referring to the above referenced passages, Appellants note that while the cited portions do teach a change in current and future architectures, none of the cited portions disclose an operation relating to, at least, *illustrating and quantifying a value of transforming an enterprise business model of the organization from a current “as-is” state to a proposed “to-be” business*

model, as recited in claim 1. Accordingly, Appellants submit the Examiner has failed to show how the instant feature is disclosed by the Buchanan reference.

Appellants note the Examiner has not alleged, nor can the Appellants find, *illustrating and quantifying a value of transforming an enterprise business model of the organization from a current "as-is" state to a proposed "to-be" business model*, as recited in claim 1, disclosed in either of the Frank or Golightly references. Rather, Appellants submit the Frank and Golightly references are silent with respect to this feature. Because none of Buchanan, Frank, and Golightly teaches, suggest, or disclose the instant feature Appellants submit that no proper combination of the applied art teaches or suggests each and every feature of the claimed invention. Accordingly, Appellants submit the combination of the applied art does not render the instant feature obvious.

For at least the reasons presented above, Appellants respectfully request the rejection of claim 1 as being obvious over the combination of Buchanan, Frank, and Golightly be reversed.

No Teaching of Defining the Goal as a

Corporate Directive Establishing a Final

End Point of an Enterprise Change

Contrary to the Examiner's assertion, Appellants submit Buchanan does not disclose *defining the goal as a corporate directive establishing a final end point of an enterprise change*, as recited in claim 1. The Examiner insists the instant feature is disclosed by Buchanan on page 2, paragraph 3 of Buchanan's disclosure (see above). Appellants acknowledge that Buchanan discloses aligning "business goals and IT investment plans," as recited in paragraph 3, page 2 of Buchanan's disclosure, as well as paragraphs 3-4 on page 5 and the last paragraph of page 6.

Appellants, however, do not concede that these portions of the cited references teaches, suggests, or discloses that Buchanan's "business goal" is a *directive establishing a final end point of an enterprise change*, as recited in claim 1. In fact, Buchanan's disclosure does not even remotely suggest that the disclosed "business goals" establish a final end point of an enterprise change. The Examiner, appears to concede this point but attempts to compensate for this deficiency by asserting that a goal is some result or achievement toward which effort (change) is directed. Even if this is generally true (which is not admitted), this still falls short of suggesting that Buchanan's "business goal" qualifies as a *corporate directive establishing a final end point of an enterprise change*, as recited in claim 1.

Appellants note the Examiner has not alleged, nor can the Appellants find, *defining the goal as a corporate directive establishing a final end point of an enterprise change*, as recited in claim 1, disclosed in either of the Frank or Golightly references. Rather, Appellants submit the Frank and Golightly references are silent with respect to this feature. Because none of Buchanan, Frank, and Golightly teaches, suggests, or discloses the instant feature Appellants submit that no proper combination of the applied art teaches or suggests each and every feature of the claimed invention. Accordingly, Appellants submit the combination of the applied art does not render the instant feature obvious.

For at least the reasons presented above, Appellants respectfully request the rejection of claim 1 as being obvious over the combination of Buchanan, Frank, and Golightly be reversed.

Independent Claim 32

The rejection of independent claim 32 under 35 U.S.C. §103(a) is in error, and the decision to reject this claim should be reversed.

The present invention is related to a system comprising hardware and software for managing and tracking changes in an organization. More specifically, independent claim 32 recites:

32. A system comprising hardware and software for managing and tracking changes in an organization, the system comprising:
- a system for defining at least one customer requirement for an enhancement to an enterprise architecture;
 - a system for identifying at least one capability to provide the enhancement to the enterprise architecture;
 - a system for estimating at least one of a revenue increase and a cost saving associated with the at least one capability;
 - a system for determining a value provided by the at least one capability based upon the implementation cost and the at least one of a revenue increase and the cost saving;
 - a system for storing a hierarchical relationship of a goal, the value, the at least one capability, and a resource, the hierarchical relationship having a plurality of levels with one or more dynamic links that differ between the plurality of levels;
 - a graphic user interface (GUI) for displaying the hierarchical relationship between the goal, the value which is associated with the goal, the at least one capability which represents critical functions for ensuring delivery of the value, and one or more resources which enables the at least one capability;
 - a system for partitioning information relevant to enterprise decision making for evolutionary change by creating categories of the information and relating these categories to one another and managing the categories of the information using an automated system, the information being defined by at least one of the value, the at least one capability, and operational resources; and
 - a system for capturing and linking process measurements from one or more external modeling tools to a database to allow process performance to be accessed by the system,
- wherein the system for managing and tracking changes captures and displays current resources of the organization and how they relate to the organizations' mission in real-time, tracks which specific resources directly support the capabilities, and illustrates and quantifies a value of transforming an enterprise business model of the organization from a current "as-is" state to a proposed "to-be" business model.

Appellants submit that no proper combination of the applied art teaches or suggests each and every feature of the claimed invention.

No Teaching of the System for Managing and

Tracking Changes Captures and Displays

Current Resources of the Organization and How

They Relate to the Organizations' Mission in Real-Time

Appellants submit that the combination of Buchanan, Frank, and Golightly does not disclose *the system for managing and tracking changes captures and displays current resources of the organization and how they relate to the organizations' mission in real-time*, as recited in claim 32.

As discussed above, Buchanan, while speaking in very general terms about Enterprise Architecture processes, never discloses, with any particularity, how the processes are to be carried out or implemented. In the Office Action, the Examiner relied on paragraphs 3 and 4 of page 5 for disclosing *the system for managing and tracking changes captures and displays current resources of the organization and how they relate to the organizations' mission in real-time*, as recited in claim 32. However, as discussed above, neither of paragraphs 3 and 4 of page 5 discloses any information related to displaying current resources of an organization and how they relate to the organization's mission in real time. Rather, the cited passages only generally discuss an enterprise business architecture. Furthermore, while the passages may indicate that the architecture includes goals and players who can perform various operations, the cited portions clearly fail to disclose, at least, *the system for managing and tracking changes captures and displays current resources of the organization and how they relate to the organizations' mission in real-time*, as recited in claim 32. Accordingly, Appellants submit the Examiner has failed to show the instant feature is disclosed by Buchanan.

Appellants further submit that Frank does not disclose, at least, the *system for managing and tracking changes captures and displays current resources of the organization and how they relate to the organizations' mission in real-time*, as recited in claim 32. The Examiner asserts the instant features are disclosed in Frank and the Examiner refers to FIGS. 3 and 4 Frank's disclosure for support. However, as explained above, Frank never discloses, with any particularity, a system that captures and displays current resources of an organization and how they relate to the organizations' mission in real time. Furthermore, Appellants submit FIGS. 3 and 4 do not show the claimed features. Accordingly, Appellants submit Frank cannot be relied on for disclosing the instant features.

Golightly discloses a system and method for asynchronous distributed optimization of an enterprise. However, Golightly makes no mention of *system for managing and tracking changes captures and displays current resources of the organization and how they relate to the organizations' mission in real-time*, as recited in claim 32. Rather, Golightly is silent regarding this feature.

As outlined above, none of Buchanan, Frank, and Golightly teach, suggest, or disclose, at least, *system for managing and tracking changes captures and displays current resources of the organization and how they relate to the organizations' mission in real-time*, as recited in claim 32. Therefore, Appellants submit that no proper combination of the applied art teaches or suggests each and every feature of the claimed invention. Accordingly, Appellants submit the combination of the applied art does not render the instant feature obvious.

For at least the reasons presented above, Appellants respectfully request the rejection of claim 32 as being obvious over the combination of Buchanan, Frank, and Golightly be reversed.

No Teaching of Illustrates and Quantifies a

Value of Transforming an Enterprise Business**Model of the Organization from a Current****"As-Is" State to a Proposed "To-Be" Business Model**

Contrary to the Examiner's assertion, Buchanan does not disclose *illustrates and quantifies a value of transforming an enterprise business model of the organization from a current "as-is" state to a proposed "to-be" business model*, as recited in claim 32. The Examiner insists the instant feature is disclosed by Buchanan. In the Office Action, the Examiner asserts that: page 2, paragraph 3 of Buchanan's disclosure teaches identifying gaps between current state and future architectures; page 5 discloses current and future state models; and page 3 discloses using value measures to guide decisions. The Examiner also asserts page 7 teaches the above features.

Referring to the above referenced passages Appellants note that while the cited portions do teach a change in current and future architectures, none of the cited portions disclose an operation relating to illustrating and quantifying a value of transforming an enterprise business model of an organization from a current "as is" state to a "to-be" business model. Accordingly, Appellants submit the Buchanan cannot be relied on for disclosing, at least, *illustrates and quantifies a value of transforming an enterprise business model of the organization from a current "as-is" state to a proposed "to-be" business model*, as recited in claim 32. Accordingly, Appellants submit the Examiner has failed to show how the instant feature is disclosed by the Buchanan reference.

Appellants note the Examiner has not alleged, nor can the Appellants find, *illustrates and quantifies a value of transforming an enterprise business model of the organization from a current "as-is" state to a proposed "to-be" business model*, as recited in claim 32, disclosed in either of the Frank or Golightly references. Rather, Appellants submit the Frank and Golightly

references are silent with respect to this feature. Because none of Buchanan, Frank, and Golightly teaches, suggests, or discloses the instant feature Appellants submit that no proper combination of the applied art teaches or suggests each and every feature of the claimed invention. Accordingly, Appellants submit the combination of the applied art does not render the instant feature obvious.

For at least the reasons presented above, Appellants respectfully request the rejection of claim 32 as being obvious over the combination of Buchanan, Frank, and Golightly be reversed.

Independent Claim 52

The rejection of independent claim 52 under 35 U.S.C. §103(a) is in error, and the decision to reject this claim should be reversed.

Independent claim 52 recites:

52. A computer program product usable for managing and tracking changes in an organization and comprising a computer usable storage medium having readable program code embodied in the medium, the computer program product includes:
 - a first computer code to define at least one customer requirement for an enhancement to an enterprise architecture;
 - a second computer code to identify at least one capability to provide the enhancement to the enterprise architecture;
 - a third computer code to estimate at least one of a revenue increase and a cost saving associated with the at least one capability;
 - a fourth computer code to determine a value provided by the at least one capability based upon the implementation cost and the at least one of a revenue increase and the cost saving;
 - a fifth computer code to partition information relevant to enterprise decision making for evolutionary change by creating categories of the information and relating these categories to one another and manage the categories of the information using an automated system, the information being defined by at least one of the value, the at least one capability, and operational resources;
 - a sixth computer code to capture and link process measurements from one or more external modeling tools to a database to allow process performance to be accessed;

a seventh computer code to store a hierarchical relationship of a goal, the value, the at least one capability, and a resource, the hierarchical relationship having a plurality of levels with one or more dynamic links that differ between the plurality of levels; and

an eighth computer code to display on a graphic user interface (GUI) the hierarchical relationship between the goal, the value which is associated with the goal, the at least one capability which represents critical functions for ensuring delivery of the value, and one or more resources which enables the at least one capability,

wherein the goal is defined as a corporate directive establishing a final end point of an enterprise change, the value is defined as a customer value, the at least one capability is a strategic capability that represents critical functions that the organization must be capable of doing to insure delivery of the customer value, and the resource is defined as a physical component that must be present and supports the at least one capability.

Appellants submit that no proper combination of the applied art teaches or suggests each and every feature of the claimed invention.

No Teaching of the Goal is Defined as a Corporate

Direcive Establishing a Final End Point of an Enterprise Change

Contrary to the Examiner's assertion, Appellants submit Buchanan does not disclose *the goal is defined as a corporate directive establishing a final end point of an enterprise change*, as recited in claim 52. The Examiner insists the instant feature is disclosed by Buchanan on page 2, paragraph 3 of Buchanan's disclosure (see above). Appellants acknowledge that Buchanan discloses aligning "business goals and IT investment plans," as recited in paragraph 3, page 2 of Buchanan's disclosure, as well as paragraphs 3-4 on page 5 and the last paragraph of page 6. Appellants do not concede that these portions of the cited references teaches, suggests, or discloses that Buchanan's "business goal" is *defined as a corporate directive establishing a final end point of an enterprise change*, as recited in claim 52. In fact, Buchanan's disclosure does not even remotely suggest that the disclosed "business goals" establish a final end point of an

enterprise change. As mentioned above, the Examiner appears to concede this point but attempts to compensate for this deficiency by asserting that a goal is some result or achievement toward which effort (change) is directed. Even if this is generally true (which is not admitted), this still falls short of suggesting that Buchanan's "business goal" qualifies as *the goal is defined as a corporate directive establishing a final end point of an enterprise change*, as recited in claim 52. Appellants note the Examiner has not alleged, nor can the Appellants find, *the goal is defined as a corporate directive establishing a final end point of an enterprise change*, as recited in claim 52, disclosed in either of the Frank or Golightly references. Rather, Appellants submit the Frank and Golightly references are silent with respect to this feature. Because none of Buchanan, Frank, and Golightly teaches, suggest, or disclose the instant feature Appellants submit that no proper combination of the applied art teaches or suggests each and every feature of the claimed invention. Accordingly, Appellants submit the combination of the applied art does not render the instant feature obvious.

For at least the reasons presented above, Appellants respectfully request the rejection of claim 52 as being obvious over the combination of Buchanan, Frank, and Golightly be reversed.

Dependent Claims 2-8, 33-41, and 53-62

Claims 2-8, 33-41, and 53-62 depend from one of claims 1 and 32 and are believed to be allowable over the applied art at least by virtue of their dependencies on their allowable base claims. Accordingly, Appellants respectfully request the rejections of claims 2-8, 33-41, and 53-62 as being obvious over the combination of Buchanan, Frank, and Golightly be reversed.

(B) Claim 63 was rejected under 35 U.S.C. §103(a) for allegedly being unpatentable over Paper entitled ALIGNING ENTERPRISE ARCHITECTURE AND IT INVENTMENTS WITH CORPORATE GOALS by BUCHANAN et al. (“BUCHANAN”) in view of Paper entitled Multi-Perspective Enterprise Modeling (MEMO) – Conceptual Framework and Modeling Languages by FRANK (“FRANK”) and in further view of U.S. Patent Application Publication No. 2003/0046130 to GOLIGHTLY et al. (“GOLIGHTLY”) and in further view of References Architectures for Enterprise Integration by Chalmeta (“Chalmeta”).

Appellants submit claim 63 is allowable at least by virtue of its dependency on claim 1.

Accordingly, Appellants respectfully request the rejection of claim 63 be withdrawn.

Conclusion

In view of the foregoing remarks, Appellants submit that claims 1-8, 10, 32-41, and 52-63 are patentably distinct from the prior art of record and are in condition for allowance.

Accordingly, Appellants respectfully request that the Board reverse the Examiner’s rejection of claims 1-8, 10, 32-41, and 52-63 and remand the application to the Examiner for allowance of the pending claims.

Respectfully submitted,



Andrew M. Calderon
Registration No. 38,093

Roberts, Mlotkowski, Safran & Cole PC
P.O. Box 10064
McLean, VA 22102
Phone: 703.677.3011
Fax: 703.848.2981
Email: acalderon@rmsclaw.com

(VIII) CLAIMS APPENDIX

The following is a listing of the claims involved in the appeal.

1. A method for managing and tracking changes in an organization, the method comprising the steps of:

defining at least one customer requirement for an enhancement to an enterprise architecture;

identifying at least one capability to provide the enhancement to the enterprise architecture;

estimating at least one of a revenue increase and a cost saving associated with the at least one capability;

determining a value provided by the at least one capability based upon an implementation cost and the at least one of the revenue increase and the cost saving;

using a database to store a hierarchical relationship of a goal, the value, the at least one capability, and a resource, the hierarchical relationship having a plurality of levels with one or more dynamic links that differ between the plurality of levels;

displaying the hierarchical relationship between the goal, the value which is associated with the goal, the at least one capability which represents critical functions for ensuring delivery of the value, and one or more resources which enables the at least one capability;

capturing and linking process measurements from one or more external modeling tools to the database to allow process performance to be accessed by the system;

using a system implemented on a computer platform to partition information relevant to enterprise decision making for evolutionary change by creating categories of the information and relating these categories to one another, the information being defined by at least one of the value, the at least one capability, and operational resources; and

using an automated system to manage the categories of the information,

wherein the method further comprises one or both of:

(i) capturing and displaying current resources of the organization and how they relate to the organizations' mission in real-time, directly tracking which specific resources directly support the capabilities, and illustrating and quantifying a value of transforming an enterprise business model of the organization from a current "as-is" state to a proposed "to-be" business model; and

- (ii)defining the goal as a corporate directive establishing a final end point of an enterprise change, defining the value as a customer value, the at least one capability is a strategic capability that represents critical functions that the organization must be capable of performing to insure delivery of the customer value, and defining the resource as a physical component that must be present and supports the at least one capability.
2. The method of claim 1, further comprising the steps of:
mapping the at least one customer requirement to the at least one capability; and
comparing the value provided by the at least one capability with another value provided by at least one other capability and determining which capability provides optimum value.
3. The method of claim 1, wherein the identifying step includes identifying one or more strategic resources to support the at least one capability.
4. The method of claim 3, wherein the identifying at least one capability step includes identifying at least one of a business process, a personnel skill/competency, a physical entity, an information technology, a system component, and an infrastructure component.
5. The method of claim 3, further comprising assigning a weight to the one or more strategic resources and prioritizing the one or more strategic resources based on the assigned weight.
6. The method of claim 3, further comprising the step of assigning outcome based performance metrics to the one or more strategic resources.
7. The method of claim 6, further comprising the step of implementing the one or more strategic resources and tracking the one or more strategic resources based on the outcome based performance metrics.
8. The method of claim 1, further comprising the steps of:
assigning a weight to the at least one capability; and
prioritizing the at least one capability based on the assigned weight.

10. The method of claim 1, further comprising the steps of:
 - assigning outcome based performance metrics to the at least one capability; and
 - implementing the at least one capability and tracking the at least one capability based on the outcome based performance metrics.
32. A system comprising hardware and software for managing and tracking changes in an organization, the system comprising:
 - a system for defining at least one customer requirement for an enhancement to an enterprise architecture;
 - a system for identifying at least one capability to provide the enhancement to the enterprise architecture;
 - a system for estimating at least one of a revenue increase and a cost saving associated with the at least one capability;
 - a system for determining a value provided by the at least one capability based upon the implementation cost and the at least one of a revenue increase and the cost saving;
 - a system for storing a hierarchical relationship of a goal, the value, the at least one capability, and a resource, the hierarchical relationship having a plurality of levels with one or more dynamic links that differ between the plurality of levels;
 - a graphic user interface (GUI) for displaying the hierarchical relationship between the goal, the value which is associated with the goal, the at least one capability which represents critical functions for ensuring delivery of the value, and one or more resources which enables the at least one capability;
 - a system for partitioning information relevant to enterprise decision making for evolutionary change by creating categories of the information and relating these categories to one another and managing the categories of the information using an automated system, the information being defined by at least one of the value, the at least one capability, and operational resources; and
 - a system for capturing and linking process measurements from one or more external modeling tools to a database to allow process performance to be accessed by the system,

wherein the system for managing and tracking changes captures and displays current resources of the organization and how they relate to the organizations' mission in real-time, tracks which specific resources directly support the capabilities, and illustrates and quantifies a value of transforming an enterprise business model of the organization from a current "as-is" state to a proposed "to-be" business model.

32. The system of claim 32, further comprising a component to map the at least one customer requirement to the at least one capability.

33. The system of claim 32, further comprising a component to compare the value provided by the at least one capability with a value provided by at least one other capability and to determine which capability provides optimum value.

34. The system of claim 32, wherein the enterprise architecture includes at least one of a hardware architecture and a software architecture.

35. The system of claim 32, wherein the component to identify at least one capability identifies one or more strategic resources to support the at least one capability and the one or more strategic resources includes at least one of a business process, a personnel skill/competency, a physical entity, an information technology, a system component, and an infrastructure component.

36. The system of claim 36, further includes a component to assign a weight to the one or more strategic resources and a component to prioritize the one or more resources based on the assigned weight.

37. The system of claim 36, further includes a component to assign outcome based performance metrics to the one or more strategic resources.

38. The system of claim 38, further includes a component to track the one or more strategic resources based on the outcome based performance metrics.

39. The system of claim 32, further comprising:

- a component to assign a weight to the at least one capability; and
- a component to prioritize the at least one capability based on the assigned weight.

40. The system of claim 32, further comprising a component to assign outcome based performance metrics to the at least one capability.

52. A computer program product usable for managing and tracking changes in an organization and comprising a computer usable storage medium having readable program code embodied in the medium, the computer program product includes:

a first computer code to define at least one customer requirement for an enhancement to an enterprise architecture;

a second computer code to identify at least one capability to provide the enhancement to the enterprise architecture;

a third computer code to estimate at least one of a revenue increase and a cost saving associated with the at least one capability;

a fourth computer code to determine a value provided by the at least one capability based upon the implementation cost and the at least one of a revenue increase and the cost saving;

a fifth computer code to partition information relevant to enterprise decision making for evolutionary change by creating categories of the information and relating these categories to one another and manage the categories of the information using an automated system, the information being defined by at least one of the value, the at least one capability, and operational resources;

a sixth computer code to capture and link process measurements from one or more external modeling tools to a database to allow process performance to be accessed;

a seventh computer code to store a hierarchical relationship of a goal, the value, the at least one capability, and a resource, the hierarchical relationship having a plurality of levels with one or more dynamic links that differ between the plurality of levels; and

an eighth computer code to display on a graphic user interface (GUI) the hierarchical relationship between the goal, the value which is associated with the goal, the at least one

capability which represents critical functions for ensuring delivery of the value, and one or more resources which enables the at least one capability,

wherein the goal is defined as a corporate directive establishing a final end point of an enterprise change, the value is defined as a customer value, the at least one capability is a strategic capability that represents critical functions that the organization must be capable of doing to insure delivery of the customer value, and the resource is defined as a physical component that must be present and supports the at least one capability.

52. The method of claim 1, wherein the at least one customer requirement is defined in response to a request by a customer.

53. The method of claim 53, wherein the value is monetary or in terms of strategic business worth.

54. The method of claim 54, wherein the outcome based performance metrics are defined and tested by conducting facilitated working sessions or building simulation models.

55. The method of claim 55, wherein the estimates are at least one of entered, recorded, or modified as additional real performance information is observed.

56. The method of claim 1, further comprising allowing at least one organizational executive to track functionality and flag one or more of the at least one capability.

57. The method of claim 8, further comprising using the assigned weight to make a decision based on one or more of the implementation cost, the revenue increase, and the cost saving.

58. The method of claim 1, further comprising providing the user with a plurality of dynamic links to operational elements of the system, the plurality of dynamic links structured to link a business model vision, a transition plan, a strategic plan, a business process, a business case, the at least one customer requirement, an operational model, a functional model, a component model, and a lifecycle costing to the system.

59. The method of claim 61, further comprising storing updates to the database dynamically as changes are made to the hierarchical relationship.
60. The method of claim 1, further comprising using the system to transition the at least one capability into actual operations.
61. The method of claim 61, further comprising determining whether the at least one capability supports and satisfies a customer value.
62. The method of claim 62, further comprising conducting a tradeoff analysis and a business case analysis, the tradeoff analysis being based on a cost, a time factor, and a benefit.

(IX) EVIDENCE APPENDIX

This section lists evidence submitted pursuant to 37 C.F.R. §§1.130, 1.131, or 1.132, or any other evidence entered by the Examiner and relied upon by Appellant in this appeal, and provides for each piece of evidence a brief statement setting forth where in the record that evidence was entered by the Examiner. Copies of each piece of Evidence are provided as required by 37 C.F.R. §41.37(c)(1)(ix).

NO.	EVIDENCE	BRIEF STATEMENT SETTING FORTH WHERE IN THE RECORD THE EVIDENCE WAS ENTERED BY THE EXAMINER
1	N/A	N/A

(X) RELATED PROCEEDINGS APPENDIX

Pursuant to 37 C.F.R. §41.37(c)(1)(x), copies of the following decisions rendered by a court or the Board in any proceeding identified above in the Related Appeals and Interferences section.

NO.	TYPE OF PROCEEDING	REFERENCE NO.	DATE
1	N/A	N/A	N/A